

## **REMARKS**

Claims 1-18 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

### **Information Disclosure Statement:**

The Office Action asserted that the Information Disclosure Statement filed by Applicants on 6/8/01 fails to comply with 37 CFR 1.98(a)(2), which requires a copy of a publication or that portion which caused it to be listed. Specifically, the Office Action asserts that IEEE Draft Standard for High Performance Serial Bus Bridges, P1394.1, Draft 0.15, dated January 11, 2001 (listed as Reference AF on Applicants' Information Disclosure Statement) does not include an Appendix E, to which the Examiner's attention was specifically directed. The Examiner noted that Reference AF includes Annexes A-D.

Applicants note that Reference AF further includes Annex E, which forms an informational appendix to the body of the draft standard. For the Examiner's convenience, a copy of the relevant portion of Reference AF is included along with a duplicate Form PTO-1449. Applicants request that the Examiner consider Reference AF, and initial and return Form PTO-1449. As evidenced by the enclosed copy of the date-stamped postcard, the Patent and Trademark Office acknowledged receipt of Reference AF in its entirety on June 8, 2001. Consequently, Applicants believe no fee is due. However, if any fee should be required, the Commissioner is authorized to charge said fee to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-87600/BNK.

### **Section 103(a) Rejection:**

The Office Action rejected claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over Talluri et al. (U.S. Patent 6,748,429) (hereinafter, "Talluri") in view of

Fukui (U.S. Patent 6,131,119). Applicants traverse this rejection as set forth in detail below.

The Talluri patent is not prior art to the present application. The American Inventors Protection Act of 1999 amended 35 U.S.C. § 103(c) to state that art which qualifies as prior art only under § 102(e), (f) or (g) is not available for rejections under § 103 if that art and the subject matter of the application under examination were owned by or subject to an obligation of assignment to the same assignee at the time the invention was made. This change to 35 U.S.C. § 103(c) is effective for any application filed on or after November 29, 1999. The present application is an application for patent filed after November 29, 1999. At the time the invention was made, the subject matter of present application and the Talluri patent were both owned by or subject to an obligation of assignment to the same assignee, Sun Microsystems, Inc. Therefore, the amendment to 35 U.S.C. § 103(c) made by the American Inventors Protection Act of 1999 applies to the present application and operates to exclude the Talluri patent as available prior art for rejections under 35 U.S.C. § 103.

Since the Talluri patent is not prior art to the present application, Applicants submit that claims 1-18 are patentable over the cited art.

## CONCLUSION


Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicants hereby petition for such extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-87600/BNK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☒ Annex E of Reference AF and Form PTO-1449

Respectfully submitted,

  
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